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OFFICE OF PETITIONS

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BOSTON MA 02210-2206

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|----------------------------|---|------------------------|
| In re Application of | : | |
| Arthur Kreig | : | ON APPLICATION FOR |
| Application No. 10/613,228 | : | PATENT TERM ADJUSTMENT |
| Filed: July 3, 2003 | : | |
| Attorney Docket No. | : | |
| C1037.70045US00 | : | |

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION UNDER 37 C.F.R. § 1.705(B) filed May 27, 2009. Applicant requests that the determination of patent term adjustment be corrected from zero (0) days to eight hundred sixty three (863) days. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the

request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

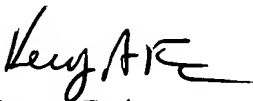
The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the 37 CFR 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.

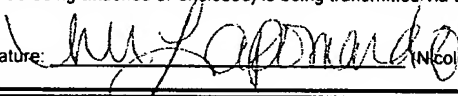
A handwritten signature in black ink, appearing to read "Kery Fries", with a stylized flourish at the end.

Kery Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration

Docket No.: C1037.70045US00
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Arthur M. Krieg
Serial No.: 10/613,228
Confirmation No.: 4680
Filed: July 3, 2003
For: NUCLEIC ACID COMPOSITIONS FOR STIMULATING
IMMUNE RESPONSES
Examiner: N. M. Minnifield
Art Unit: 1645

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| Certificate of Electronic Filing Under 37 CFR 1.8 | |
| I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4). | |
| Dated: <u>May 27, 2009</u> | Signature:  (Nicole Millette Lapomardo) |

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705

Dear Madam:

In accordance with 37 CFR §1.705(b), Applicant requests reconsideration of the patent term adjustment ("PTA") for U.S. Application No. 10/613,228 ("the '228 Application"). Applicant provides, below, a statement of the facts involved, specifying the correct PTA and the bases under 37 CFR §1.702 for the adjustment, the relevant dates for which adjustment is sought, and the adjustment to which the patent is entitled.

1. On 02/27/2009, the U.S. Patent and Trademark Office ("USPTO") mailed a Notice of Allowance and Determination of Patent Term Adjustment (Exhibit 1) for U.S. Application No. 10/613,228, which indicated that the '228 Application was entitled to a PTA of 0 days.

2. According to the Patent Term Adjustments page (Exhibit 2) of the Patent Application Information Retrieval (PAIR) system, the USPTO accorded the '228 Application a PTA of 110 days for delays that occurred at the USPTO, but reduced the PTA to 0 days because Applicant had allegedly incurred 385 days of delay.

3. Applicant submits that the correct PTA should be 863 days, which is the net USPTO delay of 1248 days minus the apparent net Applicant delay of 385 days.

4. The difference between what Applicant submits is the correct PTA (863 days) and what the Notice of Allowance and Determination of Patent Term Adjustment states is the PTA (0 days) results from the USPTO's failure to issue the '228 Application within three years of its actual filing date, i.e. by 07/03/2006. *See* 35 U.S.C. § 154(b)(1)(B). The USPTO has not included this delay in its calculation of the PTA shown in the PAIR system.

5. Although the issue date of the '228 Application is unknown, the Notice of Allowance and Determination of Patent Term Adjustment assumes that the patent will issue on 09/08/2009, which is the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of the Notice. The period of delay thus began on the first day following the end of the three-year period (07/04/2006), will conclude on the assumed issue date of 09/08/2009, and results in a USPTO delay of 1163 days.

6. The net USPTO delay of 1248 days is the sum of the delay for failure to issue the '228 Application within the 3-year period (1163 days) and the USPTO delay periods shown in PAIR (110 days) minus the number of days these periods overlap on the calendar (25 days). *See Wyeth v. Dudas*, 580 F. Supp. 2d at 138, 141 (D.D.C. 2008) (holding that the "only way that periods of time can 'overlap' is if they occur on the same day"). The periods of overlap occurred from 02/28/2007 through 03/21/2007 (22 days) and from 08/18/2008 through 08/20/2008 (3 days).

7. A terminal disclaimer was not filed in this case and the '228 Application is not subject to a terminal disclaimer.

Conclusion

Based on the foregoing, Applicant respectfully submits that the correct PTA should be 863 days and not 0 days as listed in the Notice of Allowance and Determination of Patent Term Adjustment. The 863 days of PTA results from the USPTO's failure to issue the '228 Application within 3 years of its filing date.

Applicant submits \$200.00, which is the fee set forth in 37 CFR § 1.18(e) for filing an application for PTA. If there is any additional fee occasioned by this application and request that is not covered by the enclosed fee, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,



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Date: May 27, 2009
x05.27.09